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IN THE

Supreme Court of the United States

October Term, 1946
No. 1273-1274

REFRIGERATION PATENTS CORPORATION,
Petitioner,

against

STEWART-WARNER CORPORATION,
Respondent.

POTTER REFRIGERATOR CORPORATION,
Petitioner,

against

STEWART-WARNER CORPORATION,
Respondent.

PETITION FOR WRITS OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF

LEONARD A. WATSON,
Counsel for Petitioners.

ELMER R. HELFERICH,
GEORGE A. CHRITTON,
of Counsel.

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PETITION FOR WRITS OF CERTIORARI

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, Refrigeration Patents Corporation and Potter Refrigerator Corporation, respectively pray for writs of certiorari to the United States Circuit Court of Appeals for the Seventh Circuit to review its decision filed February 4, 1947 herein which overrode jury verdicts.

A certified transcript of the combined record in these two cases (tried together before the same jury), and the proceedings in the Circuit Court of Appeals, is furnished herewith pursuant to Rule 38 of this Court.[1]

Summary Statement of the Matter Involved

These are two actions at law, under R.S. 4919, 35 U.S.C. §67, wherein petitioner Refrigeration Patents Corporation charged respondent Stewart-Warner Corporation with infringing patent No. 2,056,165 to Bronaugh and Potter (R. IV, pp. 2686-91), and petitioner Potter Refrigerator Corporation charged respondent Stewart-Warner Corporation with infringing patents Nos. 2,171,712 and 2,258,959 both to Potter (R. IV, pp. 2694-2705).

After a seven weeks trial in Chicago before Judge LaBuy and a jury, the jury rendered three verdicts whereby they found:

(1) Stewart-Warner Corporation guilty as to patent 2,056,165 and assessed damages of $225,000 (R. IV, p. 2620).

(2) Stewart-Warner Corporation guilty as to patent 2,171,712 and assessed damages of $13,000 (R. IV, p. 2622).

(3) Stewart-Warner Corporation not guilty as to patent 2,258,959 (R. IV, p. 2621).

At the close of petitioners' evidence and again at the close of all the evidence, motions of Stewart-Warner Corporation for directed verdicts were denied (R. IV, pp. 2589-90, 2592; 2618-9). After entry of judgments, Stewart-War-

[1] The record is in four volumes and all references herein are to volume and page number.

ner Corporation moved for a new trial and for judgment notwithstanding the verdicts. Both motions were denied (R. IV, pp. 2627-31), as was also its petition for rehearing (R. IV, pp. 2631, 2636-7).

Judge LaBuy's memorandum on that petition (R. IV, pp. 2635-6) states as follows:

> "These cases were submitted to the jury (having been tried together) on the questions of the validity of the claims in suit of said patents Nos. 2,056,165 and 2,171,712, and of the infringement of said claims by the defendant; the trial of said issues lasted for almost seven weeks in open Court; a great deal of evidence was offered by the parties to the suits, and submitted to the jury in the two cases, in open Court, including the oral testimony and the depositions of a large number of witnesses, and numerous exhibits, both paper and physical; the jury was carefully charged by the Court as to the law on the issues involved; the charge given by the Court to the jury was gone over with counsel for the parties by the Court at great length before the charge was read to the jury; and the jury returned their verdicts finding the claims in suit of said patents Nos. 2,056,165 and 2,171,712 valid and infringed.
>
> "The Court, as well as the jury, saw the witnesses, heard their testimony, and had full opportunity to observe their demeanor on the witness stand. The credibility of the witnesses and the weight to be given to their testimony were matters for the jury to determine and give consideration to, and arrive at their verdicts. The verdicts, as rendered, are amply supported by the evidence, and by the predominant weight of the evidence introduced.
>
> "The Court is of the opinion that the validity and infringement of the claims in suit of said two

> patents have been fully established by a clear preponderance of all the evidence offered and received during the trial; * * * the Court is of the opinion that the verdicts of the jury in finding validity, of the claims in suit of said patents Nos. 2,056,165 and 2,171,712, and their infringement by the defendant, are fully justified by the evidence."

Respondent appealed and the Circuit Court of Appeals for the Seventh Circuit rendered its opinion February 4, 1947 reversing the two judgments for petitioners.[2] In that opinion (R. IV, pp. 2776-86, so far reported only in 72 USPQ 255) the court concluded that, notwithstanding "the trial judge's admirable exposition of patent law", there was no instruction to the jury in respect of the particular requirement of sufficiency of description of a claim under R. S. 4888, 35 U. S. C. §33, and that such issue of fact was therefore ignored by the jury, and hence, was open for determination by the appellate court (R. IV, pp. 2780-81). The court then proceeded to hold patents Nos. 2,056,165 and 2,171,712 invalid as a matter of law for failure of the claims to comply with the statute (R. IV, pp. 2781-86). In this connection the court relied only on the decision of this Court in *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U. S. 1, rendered after submission of this case to the appellate court. Petitioners requested but were denied an opportunity to be heard on the meaning or inappositeness of that decision.

The instructions to the jury appear in the record at volume III, pages 1871 to 1893. The instructions with re-

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[2] Petitioner, Potter Refrigerator Corporation, took no appeal from that part of the Judgment (R. IV, pp. 2622-3) which held no recovery should be had on patent 2,258,959.

spect to the requirements of R. S. 4888, 35 U. S. C. §33 appear at pages 1873-4, which in part are in the precise words of that statute, and where they deviate, the departure transcends the rigor of that statute.[3] The instructions on this point were in the form submitted by respondent and it requested no different or additional instructions thereon. There was no objection or claim of misdirection or non-direction by respondent.

Jurisdiction

The judgments of the Circuit Court of Appeals were entered February 4, 1947 (R. IV, pp. 2787-8); and a petition for rehearing was denied without opinion on March 20, 1947 (R. IV, p. 2790). The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by Act of February 13, 1925.

Questions Presented

1. In the absence of any objection to instructions delivered by a United States District Court to a jury, *and* in the absence of any request for any additional instruction, may a Circuit Court of Appeals, on the basis of its conclusion that no instruction was delivered in respect of a specified issue of fact within the compass of a general verdict rendered by the jury, re-examine that issue of fact and overturn the verdict by substituting its own findings therefor?

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[3] The complete statute appears as an appendix to the supporting brief.

2. In an action at law for patent infringement tried before a jury, where validity of the patent has been challenged on the ground of non-compliance with the requirements of R. S. 4888, 35 U. S. C. §33 and on other grounds; where the jury has been instructed it cannot find infringement unless it also finds validity; where no objection has been taken to the charge given to the jury; where no request has been made for any additional or any different charge; where the jury, following a charge (not within the purview of Rule 49, Rules of Civil Procedure), rendered a general verdict that the patent has been infringed and assessed the infringement damages; and where, on the appeal from the judgment entered on such general verdict, appellant raised no question as to the correctness and completeness of the jury charge,—may a United States Circuit Court of Appeals, by asserting total non-direction to the jury in respect of said statute, pass on that fact issue as matter of law, and as matter of law hold the patent invalid, and reverse the judgment entered on the general verdict of the jury?

3. (For clarification of the decision of this Court in *Halliburton Oil Well Cementing Co.* v. *Walker,* 329 U. S. 1)—Did the court below correctly interpret and apply this Court's decision in the *Halliburton* case to require the holding that *new combinations* of a plurality of elements, each element being earlier well-known separately and in different associations, are not validly patentable under R. S. 4888, 35 U. S. C. §33 unless the patent claims are verbally limited to the *particular embodiment of each element* selected by the patentee for illustration of one embodiment of his invention wherein novelty resided not in any *particular element* but in *the particular combination*?

Reasons Relied on for the Allowance of the Writs

1. This is a case of peculiar gravity and general importance for it involves the construction and application of the Seventh Amendment to the Constitution.

Petitioners brought these actions at law before a jury for the reason that infringement at the time had ceased because of war restrictions prohibiting refrigerator manufacture. Petitioners were entitled under the Seventh Amendment to have all issues of fact submitted to the jury. Neither party at the trial or on the appeal questioned that all such issues had been submitted to the jury. Accordingly, the appellate court could not re-examine any fact issue otherwise than according to the rules of the common law without violating the Seventh Amendment.

The Circuit Court of Appeals has dealt with an issue of fact, which it deemed was not submitted to the jury, as an issue of law for appellate determination. It has dealt with general verdicts as though they were special verdicts.

2. The Seventh Circuit Court of Appeals palpably erred when it stated that no direction was given to the jury in respect of the legal requirements of R. S. 4888, 35 U. S. C. §33. The jury charge plainly shows that statement to be untrue.

3. Direct conflict exists between the decision sought to be reviewed and applicable decisional law of this Court.

Contrast the holding herein as follows:

> "We conclude that where, as here, there was no instruction on the matter, the issue was ignored and therefore must be determined by this court."

with the holdings of this Court, as follows:

> "But it is no ground of reversal, that the court below omitted to give directions to the jury upon any points of law which might arise in the cause, where it was not requested by either party, at the trial. It is sufficient for us, that the court has given no erroneous directions. If either party deems any point presented by the evidence to be omitted in the charge, it is competent for such party to require an opinion from the court upon that point; if he do not, it is a waiver of it."
>
> *Pennock* v. *Dialogue*, 27 U. S. 1, 15.
>
> "This point [compliance of a patent with the statutory requirements] does not appear to have been taken in the court below, and, therefore, cannot be made here. No instruction was asked or given touching the subject. It is to be presumed, until the contrary is made to appear, that the commissioner did his duty correctly in granting the reissued patent."
>
> *Klein* v. *Russell*, 86 U. S. 433, 463.

If the precedents of this Court are not entitled to respect in appraising rights for determining business conduct and the conduct of litigation, it is believed this Court should be the tribunal to announce the change. The court below has disregarded petitioners' constitutional rights by disregarding a rule of law settled by uniform decisions of this Court.

4. The decision below erroneously construes and extends the doctrine announced by this Court in *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U. S. 1.

The *Halliburton* decision has gravely disturbed the patent bar generally. Not the least of such concern has arisen

from its apparent susceptibility to differing and unpredictable interpretations by the lower courts. Indeed, the Seventh Circuit Court of Appeals itself has since furnished a conspicuous example of the unpredictability of judicial holdings in the commonest class of patent cases, namely, those where the patented invention resides in combining a plurality of individually old elements into a new combination possessing new utility.

Less than one month before the decision herein, the same court rendered its opinion in *Minnesota Mining & Mfg. Co.* v. *International Plastic Corp.*, 159 F. (2d) 554, 558. In that case, the court held the rule of the *Halliburton* decision inapplicable and sustained the patent. In the present, it held the rule applicable and invalidated the patents. The two opinions are inconsistent, and leave the patent bar and the public in serious doubt as to what the law is in the Seventh Circuit and as to what it will be held to be in other circuits. For example, in the *Minnesota Mining* case, the court held a claimed characterization of a tape adhesive as "non-offsetting" to comply with the statutory demands for exactness. In the present case, the same court held a claimed characterization of a refrigerator coil as "non-frosting" to be a non-compliance. The conflict between the two opinions urgently calls for the granting of the petition herein and the removal by this Court of the confusion now facing patentees and the public generally.

5. The patents in suit (No. 2,056,165 in particular) are of great importance. As granted, patent 2,056,165 was intended to, and does, cover an invention of wide-spread adoption in the post-war domestic refrigerator industry. Petitioners have substantially exhausted their resources

in conducting the litigation herein to date. Petitioners and the industry generally should have the benefit of a prompt and final determination by this Court of the validity of said patent.

WHEREFORE, your petitioners respectfully pray that writs of certiorari be issued to the United States Circuit Court of Appeals for the Seventh Circuit to the end that these causes may be reviewed and determined by this Court, that the judgments of the Circuit Court of Appeals may be reversed and the judgments of the District Court affirmed; and that petitioners may be granted such other and further relief as may seem proper.

LEONARD A. WATSON,
Counsel for Petitioners.

ELMER R. HELFERICH,
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BRIEF IN SUPPORT OF PETITION FOR WRITS OF CERTIORARI

Opinions of the Courts Below

The District Court wrote no formal opinion but filed a memorandum stating its reasons for refusing to direct verdicts, or grant a new trial, or grant judgments notwithstanding the verdicts (R. IV, pp. 2635-6). The opinion of the Circuit Court of Appeals has not been officially reported but is printed in Volume IV of the record at pages 2776 to 2786 and in 72 USPQ 255.

Jurisdiction

The jurisdiction is stated in the petition at page 5.

Statement of the Case

The essential facts are stated in the Summary Statement of the Matter Involved in the accompanying petition for writ of certiorari.

Specification of Errors

The errors which petitioners will urge if the writ of certiorari is issued are that the Seventh Circuit Court of Appeals erred:

1. In treating as an issue of law open to appellate determination what this Court has held to be an issue of fact to be determined only by the jury and in disregarding and violating the Seventh Amendment to the Constitution.

2. In proceeding on the erroneous assumption, that such issue of fact was totally ignored in the charge to the jury and not submitted to the jury.

3. In disregarding decisional and rule law of this Court which forbids an appellate court to reverse the jury upon an omission of an instruction not requested by either party.

4. In misinterpreting the decision of this Court in *Halliburton Oil Well Cementing Co.* v. *Walker,* 329 U. S. 1, to require the conclusion that the patents here in suit are, or that either patent is, invalid for failure to comply with R. S. 4888, 35 U. S. C. §33.

Summary of Argument

The argument will discuss the reasons relied on for the allowance of the writ.

Argument

1. The two cases for which writs are sought are actions on the case involving two patents. Since 1819 a patentee has had the right to elect to sue for infringement at law or in equity. *Tucker* v. *Spalding*, 80 U. S. 453, 455. A jury trial was had here because there was no need for an injunction but great need of avoiding the expense and delays of an accounting. In these actions it was the province of the jury to pass on *all* issues of fact. *Hodges* v. *Easton*, 106 U. S. 408, 412.

It is a fundamental principle that under proper instructions validity and infringement are questions of fact for the jury.

> "Validity and infringement are ultimate facts on which depends the question of liability. In actions at law they are to be decided by the jury."
>
> *U. S.* v. *Esnault-Pelterie*, 299 U. S. 201, 205.

At the conclusion of the seven weeks trial all issues were submitted to the jury and instructions were given by the trial court in a charge to which there was no objection by either party. Nor did either party request any additional instructions. The verdicts of the jury in favor of petitioners thus decided the issues of validity of the patent claims in suit and their infringement by respondent, as "ultimate facts".

The Seventh Amendment to the Constitution provides:

> "In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law."

The Circuit Court of Appeals ignored this and held that it was free to consider and determine whether the patent claims in suit complied with the statutory requirements of particularity (R. S. 4888, 35 U. S. C. §33) on the ground that the trial judge had omitted from his charge to the jury any "instruction on the matter" (R. IV, pp. 2780-81). The court then proceeded to re-examine and determine, adversely to petitioners, the jury's finding of fact that the patents were valid. In doing so, the court failed to abide by the Seventh Amendment to the Constitution quoted above.

2. As a stated premise to its unrestrained freedom to disregard the jury's findings of validity, the court below stated:

> "We have carefully studied the trial judge's admirable exposition of patent law in his instructions to the jury in the instant case. * * * but he nowhere cited this requirement [The patentee 'shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention.'] of the statute, or its phraseology, nor did he submit that phase of the issue of their validity to them for their consideration and determination. * * *
>
> "* * * there has been no determination of the validity of the claims, as to their sufficiency under

the statute, unless such conclusion be inherent in a verdict and judgment of recovery against the defendant. We conclude that where, as here, there was no instruction on the matter, the issue was ignored and therefore must be determined by this court" (R. IV, pp. 2780-81; 72 USPQ 255, 257-8).

To the contrary the instructions of the trial judge to the jury include the following (R. III, pp. 1871-1893):

> "The court will instruct you as to the law and the interpretation of the three patents concerned.
>
> You are the sole judge of the facts and you must apply to the facts the law and the interpretation of the patents as I shall explain them" (p. 1872).
>
> • • • •
>
> "Under the Constitution of the United States and under laws enacted by Congress, the government upon compliance with the laws and the regulations under the laws, grants patents for inventions. • • • They are presumed to be valid, but that presumption can be overcome and the patents held to be invalid if they do not fulfill or come up to legal standards and requirements. • • • It is the law that after a man has illustrated and described his device, he must particularly point out and distinctly claim the part, improvement or combination which he claims as his invention. • • • when it comes to the claims, he must there define or describe his exact invention so as clearly to distinguish it from what was old, that is, from what existed before his invention. • • • He can claim only the thing which he has invented and his claims must define that particular thing so that the public will know what that thing is and be able to avoid infringing it.
>
> The function of a patent claim is not merely to outline or to summarize what is shown and described, but rather to define the exact boundaries of the in-

> vention,—that is to determine with precision or to mark out clearly the boundaries or limits of the invention" (pp. 1873-74).

In view of this charge, the conclusion of the Circuit Court of Appeals that the jury was not instructed with respect to the statutory requirements for particularity and clarity of claim is plain error. What the Circuit Court of Appeals did by independently determining a question of fact, which it admits in its opinion was for determination by the jury, was tantamount to withdrawing that question from the jury and usurping its functions. "The right to trial by jury is a 'basic and fundamental feature of our system of federal jurisprudence'." *Bailey* v. *Central Vermont Ry.*, 319 U. S. 350, 353-4. If appellate courts can thus, by *ipse dixit*, circumvent jury verdicts, then one of the fundamental constitutional safeguards is ineffective against judicial caprice. Error on the face of the opinion frequently has been deemed ground for the grant of certiorari. See *Jurisdiction of the Supreme Court of the United States* (1936) by *Robertson and Kirkham*, §304, pp. 610, 613-5.

The case at bar is not the first wherein the Circuit Court of Appeals for the Seventh Circuit has ventured without right to undo the general verdict of a jury. In the following recent cases certiorari has been granted and the decisions of the Seventh Circuit Court of Appeals reversed for improperly dealing with jury verdicts:

> *U. S. ex rel. Willoughby* v. *Howard*, 302 U. S. 445;
> *Equitable Co.* v. *Halsey, Stuart & Co.*, 312 U. S. 410;
> *United States* v. *Johnson*, 319 U. S. 503;
> *Tennant* v. *Peoria & P. U. Ry. Co.*, 321 U. S. 29;
> *Bigelow* v. *RKO Radio Pictures*, 327 U. S. 251.

3. Furthermore, even if it be assumed that the trial judge omitted to charge the jury as to the statutory demands for clarity and exactness of patent claim, still, under the settled law of this Court, the Circuit Court of Appeals was not free independently to consider and determine the question of compliance of the patents with the statutory requirements.

The opinion below correctly states that the defenses of invalidity under R. S. 4888, 35 U. S. C. §33 were raised in the respondent's answers (R. IV, p. 2781). It fails to remark that such affirmative defenses stood denied under Rule 8 of the Rules of Civil Procedure. Thus issue was drawn and validity of the patents on that issue was a question of fact for the jury.

Patents when issued carry the presumption of compliance with *all* the statutory prerequisites necessary to their grant and validity.

Agawam Company v. *Jordan*, 74 U. S. 583, 597.

Not only was the challenge of the answers as to sufficiency of description under R. S. 4888, 35 U. S. C. §33 rebutted by the denial under Rule 8, and by the presumption of full compliance with that Statute, according to *Agawam, supra*, but actually, although respondent had the burden of proof to support this challenge and overcome this presumption, petitioners also, and prior to respondent, presented evidence on this precise issue of fact for consideration by the jury (R. I, 123-8; 133-46; 185-213), and the jury considered that evidence under "the trial judge's admirable exposition of patent law" (admirable, not less in respect of

that issue, than of all other issues), and rendered its verdicts on that issue as well as on all other issues.

These things, but more probably Judge LaBuy's memorandum denying respondent's motion for a new trial and for judgment notwithstanding the verdicts (*supra*, pp. 3-4), may explain why the Circuit Court of Appeals did not tamper with the jury's verdicts, by resorting to the "scintilla" rule, which Judge LaBuy so emphatically rejected as here totally inapplicable. Whatever individual judges may think of a jury as being the tribunal best equipped to determine patent cases, it is the tribunal authorized to do so in actions at law like the present. *Tucker* v. *Spalding*, 80 U. S. 453, 455, *supra*.

Our first Congress in the first Patent Act of 1790 made a jury the only tribunal to hear patent cases. It was not until 1819 that a later Congress permitted an equity judge to hear such cases. *Root* v. *Railway Co.*, 105 U. S. 189, 191-2. Rule 50 of the Rules of Civil Procedure has not taken from juries and conferred upon judges the power to weigh evidence and determine contested issues of fact. A jury is still the constitutional tribunal for trying facts in courts of law. *Berry* v. *U. S.*, 312 U. S. 450, 453. The appellate court's ignoring of the jury's verdicts herein is comparable to its ignoring the jury's verdict on the ground that an "issue had not been submitted to the jury" in *U. S.* v. *Socony-Vacuum Oil Co.*, 310 U. S. 150, 211, in which this Court reversed the same appellate court. In the latter case there was the further circumstance that the appellate court had been factually correct, as it is not herein, in saying that the jury did not consider the particular issue.

Where, as here, the respondent failed to assign error by the trial judge in any admission or exclusion of evi-

dence or in any instruction or lack of instruction to the jury, or to object to any instruction or to request any further instruction, the appellate court may not speculate or substitute its own judgment with respect to a fact which is concluded by the jury's verdict. As stated in *Tennant* v. *Peoria & P. U. Ry. Co.*, 321 U. S. 29, 33 (reversing the Circuit Court of Appeals for the Seventh Circuit): "No court is then justified in substituting its conclusions for those of the twelve jurors." That such is the law, as stated in the decisions of this Court, is indisputable. That the opinion of the court below is squarely in conflict with such decisions is plainly manifest by mere comparison.

The court below held:

> "As we view the record there has been no determination of the validity of the claims, as to their sufficiency under the statute, unless such conclusion be inherent in a verdict and judgment of recovery against the defendant. We conclude that where, as here, there was no instruction on the matter, the issue was ignored and therefore must be determined by this court." (R. IV, p. 2781.)

To the contrary, this Court has held in a frequently cited patent case:

> "In the argument at the bar, much reliance has been placed upon this evidence by the counsel for both parties. It has been said, on behalf of the defendants in error, that it called for other and explanatory directions from the court, and that the omission of the court to give them in the charge, furnishes a good ground for a reversal, as it would have furnished in the court below for a new trial.

But it is no ground of reversal, that the court below omitted to give directions to the jury upon any points of law which might arise in the cause, where it was not requested by either party at the trial. It is sufficient for us, that the court has given no erroneous directions. If either party deems any point presented by the evidence to be omitted in the charge, it is competent for such party to require an opinion from the court upon that point; if he do not, it is a waiver of it.

The court cannot be presumed to do more, in ordinary cases, than to express its opinion upon the questions which the parties themselves have raised at the trial."

Pennock v. *Dialogue*, 27 U. S. 1, 15.

Likewise:

"It is insisted, in this connection, that the reissue is void, because it was not for the same invention as the original patent [R. S. 4916, 35 U. S. C. 64].

This point does not appear to have been taken in the court below, and, therefore, cannot be made here. No instruction was asked or given touching the subject. It is to be presumed, until the contrary is made to appear, that the commissioner did his duty correctly in granting the reissued patent."

Klein v. *Russell*, 86 U. S. 433, 463.

See also:

Texas & Pacific Ry. Co. v. *Volk*, 151 U. S. 73, 78;
Humes v. *United States*, 170 U. S. 210, 211-2.

To an equal extent the opinion below circumvents Rule 51 of the Rules of Civil Procedure, which states in part:

> "No party may assign as error the giving or the failure to give an instruction unless he objects thereto before the jury retires to consider its verdict, stating distinctly the matter to which he objects and the grounds of his objection."

It will be remembered in the case at bar that respondent made no objection whatever to the charge. It requested no further instruction. On appeal before the court below respondent raised no point that the trial judge had erred in any admission or exclusion of evidence or any instruction or lack of instruction to the jury.

The writ prayed should be granted to resolve the plain conflict above indicated. The Court has recognized discrepancy between decisions of circuit courts of appeal and the decisional law of this Court as reasons for granting certiorari, and reversal in:

> *McCormick* v. *Burnet*, 283 U. S. 784;
> *Massey* v. *United States*, 291 U. S. 608;
> *Marine Bank* v. *Kalt-Zimmers Co.*, 293 U. S. 357, 366.

4. After the case at bar was submitted to the Circuit Court of Appeals the opinion of this Court was rendered in *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U. S. 1. That case was on writ of certiorari to the Circuit Court of Appeals for the Ninth Circuit. This Court held:

> "We understand that the Circuit Court of Appeals held that the same rigid standards of description

> required for product claims is not required for a combination patent embodying old elements only. We have a different view". (329 U. S. at p. 9).

This Court further held:

> "It is urged that our conclusion is in conflict with the decision of *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S. 405. In that case, however, the claims structurally described the physical and operating relationship of all the crucial parts of the novel combination. The Court there decided only that there had been an infringement of this adequately described invention". (329 U. S. at p. 13).

The similar view of the Circuit Court of Appeals for the Seventh Circuit had theretofore been stated in *Gilchrist Co.* v. *Kar-Lac Co.*, 29 F. (2d) 153, 154, as follows:

> "That some of the elements of the combination are claimed in terms of 'means' defined in terms of function is not objectionable in combination claims."

In support of this holding the court cited this Court's earlier decision in the *Continental Paper Bag* case.

In the case at bar the court below has now interpreted the decision of this Court in the *Halliburton* case in a manner inconsistent with the opinion of this Court in the *Continental Paper Bag* case.

In the *Halliburton* case, the patentee had added a particular single element to an *old combination*. The addition made certain echoes "more prominent on the graph and easier to count" (329 U. S. 1 at p. 7). There was a difference in degree of result but no new combination to furnish

a new kind of utility or result.[4] In the case at bar patent No. 2,056,165 (R. IV, pp. 2686-91) is for a unitary household refrigerator comprising in combination two differentially insulated food storage chambers, one cooled by a coil having an exposed surface above 32°F. (non-frosting) and the other by a coil having an exposed surface substantially below 32°F. (freezing). These elements were well known individually or in different association long before the present patentees' invention. But no item of the prior art disclosed their association in the patentees' particular (and new) unitary combination. The patentees' invention afforded greatly improved food preservation in the home and, on respondent's evidence, has greatly advanced the domestic refrigerator industry (R. I. p. 151; R. III, pp. 1990, 1994, 2009, 2013). The patent claims are directed to a *particular new and improved combination* of elements and not to any particular new or improved elements and not to any ultimate functional result.

The court below has mis-interpreted the decision of this Court in the *Halliburton* case as a wholesale condemnation of patent claims couched in language calling for a combination of cooperating elements unless the claims verbally restrict the elements by definition to the particular embodiments of each chosen by the inventor to illustrate his preferred embodiment of his combination invention. This is precisely the point on which Mr. Justice Frankfurter reserved judgment.

---

[4] The Court had found:

"The Lehr and Wyatt instrument could record all these echo waves" (329 U. S. 1, 6).

The *Halliburton* case has already occasioned wide spread concern to the patent bar.[5] The mis-interpretation of that decision by the court below, if generally applied, would require the wholesale invalidation of the majority of patents covering inventions which reside in new combinations of individually old elements, and the more basic and valuable such inventions might be the more certainly would the patents therefor be vitiated or restricted in scope to a minimal value.

---

[5] See Journal of the Patent Office Society, February 1947, Vol. XXIX No. 2, pages 105-135:

Halliburton Oil Well Cementing Co. v. Walker.
71 USPQ 175

A Technical Knockout

By Albert M. Zalkind

"In a decision dated Nov. 18, 1946, the Supreme Court handed down a decision in the case of *Halliburton* vs. *Walker* which bids to cut deeply into the heart of patent rights; a decision which if rigidly followed would not only bring about a drastic change in Patent Office policy as to 'single means clauses' but which would make the drawing of generic claims in some cases well nigh impossible."

* * *

"A decision which strikes down the instant patent and which reaches forward to stunt patents as yet unborn, and which reaches back to benight patents forming the basis of existing license agreements or under the protection of which many an entrepreneur is risking his time and his capital is a decision that appears to go far beyond the spirit and intent of R. S. 4888."

* * *

"CONCLUSION:

* * * The chaos in which the present decision throws the law will be felt for some time, and altho' the writer does not contend that established rules are necessarily sacred and must never be upset, nevertheless there must be some understanding and consideration given to the effect of upsetting patent doctrines which in many cases only specialists in patent law would be able to perceive."

The *Halliburton* decision has already been divergently applied by the court below (*supra*, p. 9). The uncertainty of its intended scope and applicability presses on all trial and appellate courts in patent cases. The peril of irremedial injury in particular cases calls for clarification now without awaiting further conflict of interpretation which has already begun.

Conclusion

It is submitted that the writs prayed for should be granted.

Respectfully submitted,

LEONARD A. WATSON,
Counsel for Petitioners.

ELMER R. HELFERICH,
GEORGE A. CHRITTON,
of Counsel.

April 21, 1947.

APPENDIX

R. S. 4888, 35 U. S. C. §33

Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible.

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IN THE

Supreme Court of the United States

October Term, 1946
Nos. 1273 and 1274

REFRIGERATION PATENTS CORPORATION,
Petitioner,

against

STEWART-WARNER CORPORATION,
Respondent.

POTTER REFRIGERATOR CORPORATION,
Petitioner,

against

STEWART-WARNER CORPORATION,
Respondent.

PETITIONERS' REPLY TO RESPONDENT'S BRIEF

LEONARD A. WATSON,
Counsel for Petitioners.

ELMER R. HELFERICH,
GEORGE A. CHRITTON,
of Counsel.

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STEWART-WARNER CORPORATION, *Respondent.*

PETITIONERS' REPLY TO RESPONDENT'S BRIEF

I. Respondent's brief is not directed to the issue presented. Your petitioners each filed an action at law against respondent. The two cases were tried before the same jury. The instructions on the point here in question were submitted by respondent's attorneys. The charge called for general verdicts in each case. No exception was taken to that charge, no request was made for any different or further charge. The jury rendered general verdicts for petitioners.

It was for the jury to take the law as instructed by the court, apply it to the facts as they found them to be, and

express their conclusions in general verdicts that would embody the law and the facts. *Walker* v. *Southern Pacific Railroad,* 165 U. S. 593, 596.

On appeal, the court below overrode the jury verdicts, not on any pretense of any misdirection but solely on the assertion of a particular non-direction.

The question presented by the petition is whether an appellate court has the right to re-examine, other than according to the rules of the common law, an issue of fact concluded by the verdict of a jury. The petition shows that such re-examination was not in accordance with the rules of the common law, and so was in defiance of the Seventh Amendment to the Constitution.

This question is a matter of such serious general consequence that the Act of March 3, 1891, which created Circuit Courts of Appeals and made their determination final in suits arising under the patent laws, nevertheless by specific provision preserved the right of appeal "in cases involving the construction or application of the Constitution of the United States". *United States* v. *American Bell Telephone Co.,* 159 U. S. 548, 551. Until the Act of February 13, 1925, Judicial Code, Section 240, petitioners could have presented this claimed violation of the Constitution as a matter of right. It is not credible that Congress, passing these acts to relieve this Court of a burden of litigation "which operated to impede the disposition of cases of peculiar gravity and general importance" (*American Bell Telephone* case, *supra,* p. 554), supposed that any court of the United States would disregard the Constitution, or if any did, that this Court would not, as matter of course, speedily require the reformation of any such abuse.

II. Respondent's brief in opposition now seeks to distract attention from the question presented, by pretending that here is the usual non-jury patent suit where judges, not juries, determine all issues. It avoids the constitutional question by devoting a large part of its eighteen pages to argument that petitioners' patents ought never to have been found valid over the prior art. Such argument is utterly beside the point. The issues of validity and infringement were issues of fact for the jury's determination and the jury determined them. That determination must stand in a federal appellate court. *Tyler* v. *Boston*, 74 U. S. 327, 331.(1)

It is not within the province of an appellate court, not even this Court, to reverse a judgment merely because it is dissatisfied with the findings of a jury. *Herencia* v. *Guzman*, 219 U. S. 44, 45. In *Express Co.* v. *Ware*, 87 U. S. 543, 545, this Court summed up the law in this one sentence:

> "We see no error in the charge, and cannot examine the evidence to ascertain whether the jury was justified in finding as it did upon the issues of fact."

In *Aetna Life Ins. Co.* v. *Ward*, 140 U. S. 76, 91, this Court said:

> "It may be that if we were to usurp the functions of the jury and determine the weight to be given to the

(1) This Court has no more right than the Seventh Circuit Court of Appeals to pass on the validity of these patents. The reason for the third of the Questions Presented, page 6 of petition, was to afford this Court an opportunity to clarify its *Halliburton* decision for the reasons stated on pages 8, 9 of the petition.

> evidence, we might arrive at a different conclusion. But that is not our province on a writ of error."

The lower court has concluded that a particular instruction was missing from the trial judge's charge. But respondent got the precise instructions it asked for in respect of Rev. Stat. 4888, 35 U. S. C. §33. The respondent admits (p. 14) that, as stated in the petition (p. 5), "The instructions on this point were in the form submitted by respondent and it requested no different or additional instructions thereon. There was no objection or claim of misdirection or non-direction by respondent". Respondent claims that the appellate court below nevertheless had the right to notice "plain error". The assertion is a pure after-thought, not presented to the court below and not found by it. More importantly, no such error existed. *Mis*direction, or refusal to give requested proper direction, would be "plain error". Neither fault occurred in the trial judge's charge herein. All requested instructions were given, and the charge as a whole was characterized by the court below as an "admirable exposition of patent law". In such circumstances, there was no error, "plain" or otherwise.

Respondent cites *United Brotherhood of Carpenters and Joiners of America* v. *United States*, 91 L. Ed. (Adv. ops.) 705, 714, but that was a case of positive misdirection compounded by refusal of proper requested direction. The opinion states (91 L. Ed. at pp. 712, 713):

> "These requested instructions were refused and instead instructions were given that stated a different concept of law * * * A failure to charge correctly is not harmless since the verdict might have resulted

> from the incorrect instruction. * * * The error is aggravated by the failure to give the correct charge upon request."

Respondent also cites *Royal Insurance Company* v. *Miller,* 199 U. S. 353, 369, and quotes:

> "As we are at liberty, however, despite the absence of an assignment of error on the subject, to consider a plain error arising on the record, we have given our attention to the subjects referred to * * *."

The remainder of the sentence reads:

> "and content ourselves with saying that we think they are devoid of merit."

The case is without pertinency.

Respondent also cites *Blanos* v. *Kulesva,* 107 Conn. 476, where the state court trial judge read to the jury a motor vehicle statute. Such reading, in the opinion of the majority of the appellate court was insufficient. The case is without any relevancy herein where only federal law can be regarded. *Sola Electric Co.* v. *Jefferson Co.,* 317 U. S. 173, 176.

If any state law could be applied it would be the law of Illinois since respondent is an Illinois corporation and these actions at law were brought in Illinois where respondent was making and selling what the jury found to be infringement. Such law is succinctly stated in *Provident Hospital* v. *Barbour,* 58 Ill. App. 421, 422:

> "It has never, in this State, been held error not to instruct, when not asked."

See also *Drury* v. *Connell*, 177 Ill. 43, 44; *Malott* v. *Hood*, 201 Ill. 202, 205; *Osgood* v. *Skinner*, 211 Ill. 229, 240; *Central etc.* v. *Ankiewicz*, 213 Ill. 631, 632; *People* v. *Lucas*, 244 Ill. 603, 614-615; *Wilkinson* v. *Service*, 249 Ill. 146, 152.

Similarly this Court said in *Mutual Life Ins. Co.* v. *Snyder*, 93 U. S. 393, 394:

> "But the omission of the learned judge to instruct the jury on a particular aspect of the case, however material, cannot be assigned for error, unless his attention was called to it with a request to instruct upon it."

There have been a great many similar pronouncements by this Court including the four cases cited on pages 19, 20, of petitioners' brief.

In one of those cases, the famous patent case, *Pennock* v. *Dialogue*, 27 U. S. 1, precisely the same argument as that now advanced by the respondent in our case was made by counsel in that case as follows (27 U. S. 1, 5, 6):

> "As the case is presented on the bill of exceptions, the court, in their charge, undertook to state the whole law of the subject-matter to the jury; and the omission to instruct them on any one point is error. If in this charge of the court anything is omitted which was matter of law for the jury, it is misdirection."

This Court's rejection of that argument is quoted on pages 19, 20 of petitioners' brief.

III. The balance of respondent's brief, under a pretense of supplying "background", is an argumentative statement, purporting to be factual, of defensive propositions which it tried—unsuccessfully—to maintain before the jury. We shall discuss this briefly, not because validity of the patents

is before this Court, but to show the need for clarification of the *Halliburton* decision.

The term "non-frosting coil" means a coil on the external surface of which moisture from the air does not freeze and accumulate. In other words, the coil temperature is kept on the upper side of 32° F. (the freezing point of water). When respondent says:

> "Non-frosting merely defines a condition or state or 'what it will do' when and only when operated in some special manner which neither the specification nor the claims explains." (Respondent's Brief, p. 12)

it is endeavoring to impute a peculiarity or abstruseness which is the veriest nonsense. The only "special" operation is that the surface temperature shall not be maintained below the freezing point of water. Nothing could be more explicit and particular in this respect than the corresponding phrases in claims 12, 14, 16 and in claim 18, which are:

> "means constructed and arranged to maintain the external surface temperature of the expander in the warmer chamber above the said freezing point"

and

> "means constructed and arranged to maintain the humidity in the warmer chamber at a relative value of at least 100 per cent at 32 degrees Fahrenheit." (Respondent's Brief, p. 8)

As any tyro knows, there are dozens of usable refrigerants, and the expansion valve setting is naturally adjusted appropriately to the one selected to obtain any internal coil temperature desired. The difference between the inside coil temperature and the outside coil temperature is naturally affected by the rate of heat flow from the latter

to the former. This, as every tyro also knows, is affected by the relative surface areas and the material of the coil wall. All these factors are within the most rudimentary knowledge of the merest apprentice in the art. It is preposterous to think that a patent specification and claim which call for a coil surface temperature above 32° F. nevertheless lack the particularity required by statute unless accompanied by the narrowing and utterly immaterial limitations such as dimensions, shape and material of the coil, physical constants of refrigerant, and expansion pressure in pounds or millimeters of mercury, which may have been fortuitously chosen by the patentee for one machine. Specifications and claims so limited would not even have the virtue of additional disclosure to aid "any person skilled in the art or science to which it appertains * * * to make * * * and use the same"; but on the contrary would tend to hinder such purpose by diverting attention to trivialities. Finally, a patent having claims with such limitations would be so narrow in scope as not to be worth the paper it was written on.

Similarly, respondent's pretense that claims 10 and 11 are defective in reciting

> "the thermal insulation of the compartments being relatively so proportioned as to admit a greater inflow of heat into the cooling compartment than into freezing compartment." (Respondent's brief, p. 9).

is sheer nonsense. Every tyro knows that the rate of heat flow through insulation is affected by

> "(1) difference in thickness, (2) difference in character, (3) difference in temperatures maintained in the two compartments, and (4) difference in temperature between the compartments and the outside atmosphere." (id.)

No part of the new concept, the new "invention" of Bronaugh & Potter resided in such details. The contribution of the patentees to the art was in providing a new unitary household refrigerator all the elements of which, separately or in other associations, were familiar and well understood to the art; *but which the patentees were first cooperatively to associate in a new combination.* The claims here are drawn to the new combination of *essential* elements, and the omission therefrom of irrelevant trivialities is a virtue not a vice.

Neither the *coil,* nor any other single *element* which entered into the patentees' new combination, constitutes the "exact point of novelty". All of the novelty of their invention was in their *combination* of old elements which never before had been similarly combined.

Respondent's brief (pp. 13-16) seizes on a reference in the opinion below (R. IV, 2780) to "the issue of clarity of phraseology", but the statute (35 U. S. C. §33) uses the words "such full, clear, concise and exact terms" with reference to sufficiency of patent *disclosure* "to enable anyone skilled in the art * * * to make * * * and use the same". Compliance in that respect, as found by the jury, was not disturbed by the court below. Where the statute deals with the patent *claims, i.e.,* the subject matter protected, it uses the words "shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention". It was on this latter point that the court below reversed the verdicts because (it said) the jury had been given "no instruction on the matter". Actually the jury had been admirably instructed on the exact matter in the language quoted in the petition (pp. 15, 16), which respondent now ignores so assiduously.

If the *Halliburton* decision was intended to be limited to cases where patentable novelty inhered in improving *one element only* of a combination, then that doctrine has no proper application to the case at bar. Unfortunately, the *Halliburton* decision has not been generally so interpreted or applied, and it is that conflict and confusion which was referred to in the petition as a further reason for its grant. Since the petition was filed, there has been reported the decision of the Circuit Court of Appeals for the First Circuit in *Leeds & Northrup Co.* v. *Doble Engineering Co.*, 73 USPQ 199. There the opinion says:

> "In the Halliburton case the Supreme Court was considering combination claims, and in doing so held that each element of a claimed combination must be described in terms of that element's physical characteristics or arrangement in the new combination apparatus, not in terms of what that element will do, i.e., in functional language, so that as a result after-discovered devices beyond the range of equivalents which might be used to accomplish the purpose served by an element of the patented combination will not be included in the monopoly of the patent."

This is another example of the need for correction and clarification referred to in petitioners' main brief, pp. 21-25.

The writs prayed for should be granted.

Respectfully submitted,

LEONARD A. WATSON,
Counsel for Petitioners.

ELMER R. HELFERICH,
GEORGE A. CHRITTON,
of Counsel.

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Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRITS OF CERTIORARI.

JOHN D. BLACK,
ALBIN C. AHLBERG,
Counsel for Respondent.

ROSS O. HINKLE,
LEON F. SHACKELL,
Of Counsel.

THE DUNTHORP-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

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RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRITS OF CERTIORARI.

SUPPLEMENTAL STATEMENT OF MATTER INVOLVED.

Respondent considers petitioners' Summary Statement of the Matter Involved to be inadequate fully to inform this Court of the issue decided by the court below. We shall,

therefore, supplement petitioners' statement with such matters as seem to us to be essential.

Although respondent had presented to the court below the additional defenses that, as a matter of law, the two patents here involved were invalid because they were anticipated (R. Vol. I, pp. 6, 64-65, 85, 98, 99) and disclosed no invention over the prior art (R. Vol. I, pp. 5-6, 65, 85, 99-100), and were not infringed (R. Vol. I, pp. 5, 54), the court below decided that the patents were invalid on the additional defense that the claims in suit fail to comply with the requirements of Rev. Stat. 4888; 35 U. S. C. A., Sec. 33 (R. Vol. I, pp. 6-7, 65, 66, 100).

The opinion states (R. Vol. IV, p. 2781):

> "We have studied the claims of the patents in suit, the points raised in appellees' brief on the issue of clarity of phraseology, and the Supreme Court's opinion in the Halliburton case, *supra* [329 U. S. 1]. We conclude there has been such a want of clarity that, as a matter of law, the patents must be held invalid."

Before stating this conclusion, the opinion said (R. Vol. IV, p. 2779):

> "We are at once confronted by the very recent opinion of the Supreme Court in the case of *Halliburton Oil Well Cementing Company* v. *Walker,* decided November 18, 1946 [329 U. S. 1]. There the Court held a patent invalid for failure to comply with Rev. Stat. 4888, 35 U. S. C. A., Sec. 33. That statute requires the patentee to state his invention in '*such full, clear, concise and exact terms* as to enable any person skilled in the art or science to which it appertains * * * to make, construct, compound, and use the same; and in the case of a machine, *he shall explain the principle* thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and *he shall particularly point out and distinctly claim the part, improvement or combination which he claims as his* invention or discovery * * *,"

The issue of "clarity of phraseology" was decided—could be decided—only with a knowledge of the background of the patents in suit and of the specific question which the court below decided adversely to them. Petitioners seem studiously to have avoided giving this Court that essential background. The petition fails to afford any clear idea of the subject matter involved, the nature of the alleged inventions purported to be covered by the claims in suit and the peculiar character of those claims. Without an understanding of these matters we believe it will not be possible for this Court to appraise the "Questions Presented" or the "Reasons Relied on for the Allowance of the Writs", or the "Specification of Errors" or the discussion thereof appearing either in the petition or in this brief in opposition. We therefore briefly sketch this necessary background.

The patents in suit relate to mechanical household refrigerators. The principal patent of the two involved is that of Bronaugh & Potter No. 2,056,165 (Petition, p. 9); and since the petition discusses only a peculiarity of one of the several claims in suit from this patent, we shall likewise limit our consideration to the Bronaugh & Potter patent. Obviously petitioners deliberately selected the critical expression of claim 10 (R. Vol. IV, p. 2690) of this Bronaugh & Potter patent as best suited to their purposes.* (Petition, p. 9.) Inability to demonstrate the soundness of their position as to this chosen expression will necessarily carry with it failure also as to the other claims in suit.

*"A non-frosting coil in the cooling compartment" is designated as element 6 in the claim chart and discussion in the opinion of the court below. (R. Vol. IV, pp. 2783-2786.)

The Background of the Bronaugh & Potter Patent.*

Refrigeration is not, as commonly believed, putting cold into something; on the contrary refrigeration is taking away or absorbing heat to produce cold (R. Vol. II, p. 1371).

In the old fashioned ice box the cake of ice does not throw out cold to its surroundings; on the contrary the cake of ice produces cold in its surroundings by taking away or absorbing heat therefrom. In the process of absorbing heat, the ice changes state from solid to liquid,—that is, it melts.

In mechanical refrigeration, a volatilizable chemical substance called a refrigerant takes the place of the cake of ice as the heat absorbing agent. Cooling is effected by causing the refrigerant to change state from a liquid to a vapor (*i.e.*, to evaporate or volatilize) because in so changing state, large quantities of heat are absorbed (R. Vol. I, p. 131; Vol. II, p. 1374). The refrigerant is circulated by a motor driven pump (compressor) through a closed circuit which includes a coil of tubing in the chamber to be chilled, and the pump and a condenser outside of the chamber (R. Vol. II, pp. 1437, 1442). The pump or compressor forces the refrigerant under pressure in liquid form through a pressure reducing or expansion valve into the coil (R. Vol. II, p. 1438). The reduction in pressure causes the liquid refrigerant to evaporate or volatilize and expand in the coil and thereby absorb heat from the chilling chamber and things stored therein (R. Vol. I, p. 131). The temperature at which the refrigerant evaporates or volatilizes in the coil and absorbs heat is determined by the setting of the expansion or pressure reducing valve; the lower the pressure, the lower temperature at which the heat is absorbed. These

* Fig. 1 of the Bronaugh & Potter patent and of the Anderson patent hereinafter referred to are reproduced in a folder at the back of this brief.

cooling coils are commonly known by the interchangeable terms evaporator, expander or chilling element (R. Vol. I, p. 133; Vol. II, p. 1389). The pump also sucks the heat-laden vapor from the cooling coil, compresses it and passes it on to the condenser where the absorbed heat is dissipated to the atmosphere and thereby the refrigerant is turned into a liquid again ready to be pumped back through the expansion valve into the cooling coil (R. Vol. I, p. 136; Vol. II, p. 1437). This cycle of evaporation to absorb heat from the chilling chamber and compression and condensation to dissipate the absorbed heat to the outside atmosphere is repeated as long as the motor drives the compressor pump (R. Vol. II, pp. 1442-3). A thermostat in the chilling chamber acts automatically to start the motor when the temperature in the chamber rises to a predetermined maximum, and to stop the motor when the temperature falls to a predetermined minimum (R. Vol. II, p. 1443). Such mechanical refrigerating systems have been known and extensively used for about 50 years (R. Vol. II, p. 1391).

In the conventional household mechanical refrigerator the cooling coil (or evaporator or expander or chilling element) is located in the food preserving chamber and usually formed about shelves for holding ice cube trays.

The refrigerators involved in these actions differ from the conventional one-chilling-element type in that the cabinet is divided by a heat insulating partition into two completely separated compartments, one to be maintained below freezing and the other to be maintained at a refrigerating temperature above freezing, each compartment having its own individual chilling element.

This idea of a two-compartment two-temperature refrigerator was not new with Bronaugh & Potter; it was ten years old before they entered the field.

In 1922 August P. Anderson Patent No. 1,439,051 was granted on just such a refrigerator (R. Vol. IV, pp. 2712 to 2718, and see folder at back of brief).

This Anderson patent refrigerator, like the Bronaugh & Potter patent refrigerator has in a single cabinet a machine compartment 20 housing a motor, compressor and condenser, a "sharp freezing" compartment 7 chilled by coil 35 and a larger "refrigerating compartment" 6 chilled by coil 40. The sharp freezing and refrigerating compartments are insulated from each other, from the machine compartment and from the outside atmosphere. The refrigerant circuit or "expansion line" includes a pressure reducing or expansion valve 33 "at the point of entrance into the freezing compartment" 6 and the coils or expanders 35 and 40 individual to the "sharp freezing" and "refrigerating" chambers, respectively, are in series in that expansion line. In this old Anderson patent there is also a thermostat in the upper warmer "refrigerating" compartment, responsive to the temperature in that compartment, to start and stop the compressor motor when the temperature rises to a predetermined maximum and falls to a predetermined minimum.

The two-chamber, two-temperature refrigerator system of the Anderson 1922 patent contains the same combination of the same elements (except one) connected together and cooperating in precisely the same way as in the Bronaugh & Potter patent refrigerator. On this point the court below said

> "* * * there was here no *new* combination of elements. There was at best an old combination with some of elements somewhat varied," (R. Vol. IV, p. 2783).

The only differences between the refrigerators of the Bronaugh & Potter patent and the prior Anderson patent are (1) the substitution in the warmer compartment of a so-called "finned coil" * for the bare (unfinned) tubing of

* Although the Bronaugh & Potter patent fails clearly to show and does not describe at all a "finned" coil, the plaintiffs did use a finned coil in refrigerators built by or under license from them between 1932 and 1938. In these finned coils the tubing was pro-

Anderson, and (2) the substitution of thicker insulation around the colder compartment than around the warmer compartment instead of insulation of the same thickness around both compartments as in Anderson.

The substitution in the upper warmer compartment of a so-called finned coil for the bare tubing of Anderson is alleged to preserve food longer without drying out and to eliminate the necessity for periodic defrosting. The use of thicker insulation around the freezing compartment than around the upper warmer compartment, rather than the same thickness of insulation around both compartments, is alleged to contribute to these and other beneficial results.

The "exact point of novelty" or the "most crucial element" is therefore merely the substitution of one kind of chilling element or expander for another kind in the upper cooling chamber as to some claims in suit; it is the difference in thickness of insulation around the two compartments as to other claims in suit.**

Instead, however, of describing this "exact point of novelty" or this "most crucial element" in "terms of its own physical characteristics or its arrangement in the new combination apparatus", the claims in suit describe this so-called finned coil "in terms of what it will do" under certain conditions but what it will *not* do under other operating conditions. In other words, the most crucial element or exact point of novelty is defined in terms of function or result. Not only that, but there is no description or direction whatsoever, either in the specification or in the

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vided with laterally projecting plates or "fins" to enlarge the exposed surface.

Respondent's refrigerator did not use finned coils.

** The arguments made by the Bronaugh & Potter attorneys before the Patent Office which finally lead to the allowance of the claims in suit show conclusively that these two elements or features are and were conceded to be the "exact point of novelty" or the "most crucial element" (For example, see Bronaugh & Potter file wrapper p. 81 and 83; R. Vol. III, pp. 2292, 2294).

claims, regarding the operating conditions under which the coil will produce the result required, or, conversely, regarding the operating conditions under which the coil will fail to produce the results required.

Thus instead of describing a finned coil, the patent specification does not even contain this expression or anything resembling or equivalent to it.

The claims in suit are equally deficient and vague.

Claim 18 describes the coil as:

> "means constructed and arranged to maintain the humidity in the warmer chamber at a relative value of at least 100 per cent at 32 degrees Fahrenheit" (R. Vol. IV, p. 2691).

Claims 12, 14 and 16 describe it as:

> "means constructed and arranged to maintain the external surface temperature of the expander in the warmer chamber above said freezing point" (R. Vol. IV, pp. 2690-1).

And claim 10 describes it as:

> "a non-frosting coil in the cooling compartment" (R. Vol. II, p. 2690).

That these three expressions are equivalent in meaning and equally functional is established beyond dispute by the testimony of the experts for both parties. Thus the petitioners' expert testified that

> "a coil is non-frosting when it is operated one way, and the same coil would be a frosting coil if it was operated another way" (R. Vol. 1. p. 232).

He further testified that these three expressions

> "are discussing the same operation, the same functions" (R. Vol. 1, p. 233).

In short there is no such thing as a "non-frosting coil" *per se;* "non-frosting" is not a physical characteristic of any coil. Whether any coil (even a finned coil) is frosting or non-frosting depends upon how it is operated. Petitioners' expert testified that:

> "If you don't want the frost to form on the coil 25, coil structure 25 of Figures 1 and 2 of Bronaugh and Potter, you so set the thermostat that the thermostat will stop the motor before the refrigerating machinery is effective to pull the temperature of the coil system down to the point that frost forms" (R. Vol 1, p. 199-200).

In their main brief before the Circuit Court of Appeals, however, petitioners argued that three variable factors (instead of only one as their expert testified) were contributory to the production of a non-frosting coil, (1) "special shaping" (e. g., finning), (2) "special thermostatic setting" (the only factor mentioned by their expert), (3) "selected refrigerant", and (4) "selected inside coil pressure" (i. e., expansion valve adjustment).

Likewise instead of claiming thicker insulation around the freezing compartment than around the warmer cooling compartment, claims 10 and 11 describe this most crucial element as:

> "the thermal insulation of the compartments being relatively so (or "so relatively") proportioned as to admit a greater inflow of heat into the cooling compartment than into the freezing compartment" (R. Vol. IV, p. 2690).

Thus claims 10 and 11, instead of describing the different thickness insulation feature as such, are couched in functional language as to "what it will do" so as to embrace all or any one or any combination of two or more of the four variables that determine the relative inflow of heat, viz., (1) difference in thickness, (2) difference in character, (3) difference in temperatures maintained in the two compartments, and (4) difference in temperature between the compartments and the outside atmosphere.

The Court Below Correctly Interpreted the Doctrine of Halliburton v. Walker and Properly Applied That Doctrine to the Claims in Suit.

The record in this case shows the soundness of the opinion of the Circuit Court of Appeals that the claims here involved are vague in description of the means to achieve the result (R. Vol. IV, p. 2786); that they are merely descriptive in the most general terms of the machine the patentees had in mind, (R. Vol. IV, p. 2786) and that if they achieved a patentable invention they failed to describe it with the precision required by Sec. 33, 35 U. S. C. A. (Rev. Stat. 4888), as interpreted by this Court in the *Halliburton* case (R. Vol. IV, p. 2785). The reasoning of the Circuit Court of Appeals, and its conclusion from the application of the *Halliburton* case clearly show that no other question is necessary to the decision of this case and to the denial of the petition here.

Petitioners' paragraph 3 of "Questions Presented" and point 4 of their "Reasons Relied on for the Allowance of the writs", of their "Specification of Errors and of their "Argument" (pp. 6, 8, 12, 21 to 25) accuse the court below of misinterpreting and extending the doctrine of *Halliburton* v. *Walker,* of incorrectly applying that doctrine to the claims in suit and of reaching a conclusion as to those claims which is inconsistent with its earlier decisions in *Minnesota Mining & Mfg. Co.* v. *International Plastic Corp.*, 159 F. (2d) 554, 558, and in *Gilchrist Co.* v. *Kar-Lac Co.* 29 F. (2d) 153, 154, and with this Court's decisions in *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S. 405.

Contrary to petitioners' contentions, the court below did correctly interpret and did not extend the *Halliburton* v. *Walker* doctrine, did properly apply that doctrine to

the claims in suit and did not reach a conclusion inconsistent with those reached in the decisions mentioned.*

The court below painstakingly charted the claims in suit element by element and meticulously analyzed them to pick out the "exact point of novelty" or the "most crucial element" (Opinion R. Vol. IV. pp. 2783 to 2786). The court below then correctly found that this "exact point of novelty" or "most crucial element" was defined in language which was not "exact", but in terms "of a *result* without the statement of the *means* whereby that result is to be obtained" (Opinion, R. Vol. IV, p. 2785). In other words the "most critical element" is described in terms of "what it will do rather than in terms of its own physical characteristics or its arrangement in the new combination apparatus" (*Halliburton* v. *Walker*). Furthermore, the court below found that:

> "Nowhere in the specifications or drawings is a special kind of coil shown whose structure, such as 'finning', might be a frost-collecting deterrent. Indeed, it was agreed by the experts of all parties that a coil may be non-frosting when it is operated in one way, and become frosted if operated in another way" (Opinion, Vol. IV, p. 2785-6).

In other words the criticism of the court below of the claims in suit was directed and applied solely to the element of each which described the only point of departure from the prior art in terms of what that departure "would do" (under certain specific unexplained but not all conditions) rather than in "terms of its own physical characteristics or its arrangement in the new combination apparatus."

There is no conflict in conclusion or in doctrine between the instant case and those cited by petitioners.

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* The clarity of the doctrine elucidated by this court in *Halliburton* v. *Walker* is attested by the fact that the court below correctly interpreted and applied it without assistance of counsel.

In the *Minnesota* v. *International* case, the court below correctly held that the *Halliburton* v. *Walker* doctrine did not apply to the claims in suit because each of the elements constituting each claim was described in terms of structure, such as (1) "a non-fibrous transparent flexible film backing having non-porous surfaces", (2) "a water-insoluble normally tacky and pressure-sensitive transparent flexible adhesive coating", and (3) "an interposed transparent primer coating".*

Each of these characteristics was structural and inherent in the element. On the contrary, "non-frosting", although unquestionably meaning above 32°F., is neither inherent nor structural nor dependent in any wise upon the arrangement of the coil in the alleged "new" combination apparatus. Non-frosting merely defines a condition or state or "what it will do" when and only when operated in some special manner which neither the specification nor the claims explains.

Gilchrist Co. v. *Kar-Lac Co.,* was decided by the court below long before the decisions of this Court in either *General Electric Co.* v. *Wabash Appliance Co.,* 304 U. S. 364, 371 or *Halliburton* v. *Walker.*** And yet the court below in *Gilchrist* v. *Kar-Lac* did not say, as petitioners intimate, that all elements of a combination claim could properly be defined in functional terms but only that "some" of them could be so defined. And, of course, under the *Halliburton* v. *Walker* doctrine that "some" could not be "the most crucial element".

In the *Continental Paper Bag* v. *Eastern Paper Bag* case

* Two typical claims of the Drew patent in suit in the *Minnesota* v. *International* case are quoted in full at page 556 of 159 F. 2d 554.

** *Halliburton* v. *Walker* is merely a fuller and more forceful exposition of the principle of and the reasons for the doctrine of *General Electric* v. *Wabash* and an unequivocal direction that the doctrine applies to "combination" claims as well as to "product" claims.

the validity of the claims was not in issue before this Court; only the issue of infringement was before it. Furthermore, as this Court pointed out in *Halliburton* v. *Walker,* the claims involved in the *Continental Paper Bag* v. *Eastern Paper Bag* case "structurally described the physical and operating relationship of all of the crucial parts of the novel combination",—a situation wholly different from that presented by the claims here in suit.

Should the Court be of opinion that any question other than the invalidity of the patents because of failure of compliance with Rev. Stat. 4888; Section 33, 35 U. S. C. A., is material, we present the following in opposition to questions 1 (Petition, p. 5), 2 and 3 (Petition, p. 6) presented by petitioner.

The Circuit Court of Appeals, on Its Own Motion, Could Notice a Plain Error in the Record, Resulting from the Failure of the Trial Court to Instruct the Jury on a Vital Issue of the Case.

For the reason that one answer suffices for both points 1 and 3 of petitioners' "Reasons Relied on for the Allowance of the Writs" and of the supporting "Argument", they will be treated together. These points likewise cover assignments 1 and 3 of the "Specification of Errors". In these points and assigned errors petitioners assert that the court below violated the Seventh Amendment to the Constitution (Petition, pp. 7, 8; Argument pp. 12, 13, 14), circumvented Rule 51 of the Rules of Civil Procedure (Argument p. 21) and disregarded decisions of this court in such cases as *Pennock* v. *Dialogue, 27 U. S. 1, 15; Klein* v. *Russell,* 86 U. S. 433, 463; *Texas & Pacific Ry. Co.* v. *Volk,* 151 U. S. 73, 78; and *Humes* v. *United States,* 170 U. S. 210, 211-2 (Petition p. 7, Argument pp. 12, 17 to 20) when it decided the vital issue of "clarity of phraseology"

against the patent claims in suit. The basis of petitioners' assertions is that no exceptions were taken to the trial court's instructions to the jury.

What petitioners overlook or ignore is that, despite the fact no error was alleged and no argument was made before the court below on the failure of the trial court to instruct the jury on the issue of "clarity of phraseology", the court below itself noticed the omission and concluded that "the issue was ignored and therefore must be decided by this court", i. e., by the court below (Opinion, R. Vol. IV, p. 2781).

Thus there is here presented not a situation where a party seeks to avail itself of an alleged error in instructions to which no exception was taken (which was the situation in the cases upon which petitioner relies) but a situation where the court below noticed a "plain error".*

There is nothing in the Seventh Amendment to the Constitution nor in Rule 51 of the Rules of Civil Procedure, nor in the decisions of this Court relied upon by petitioners which precludes a federal court of review from noticing a "plain error" even though the error is not assigned or specified, and even though the error be in a trial court's instructions to a jury.

Thus in the very recent case of *United Brotherhood of Carpenters and Joiners of America* v. *United States* 91 L. Ed. (Adv. Ops.) 705, 714 (one of several involving charges of criminal conspiracy to violate the Sherman Act) this Court reversed judgments of conviction against several defendants because of failure of the trial court

* Respondent's counsel believed at the trial, and still believe, and argued before the district court and the court below that the issue was a question of law—not of fact—on the ground that invalidity was clear upon mere construction of the claims in the light of admissions made in the file wrapper and by petitioners' own expert; and on that basis there was nothing to go to the jury and the matter of instructions was moot and immaterial.

properly to instruct the jury on the application of responsibility provisions contained in Section 6 of the Norris-LaGuardia Act (29 U. S. C. § 106); even though as to such defendants no exception had been taken to the trial court's instructions. In this connection this Court said:

> "* * * And though the failure so to charge was not excepted to, we would not be precluded from entertaining the objection" (citing cases and Rule 27 of this Court). "The erroneous charge was on a vital phase of the case and affected the substantial rights of the defendants. We have the power to notice a 'plain error' though it is not assigned or specified * * *" (citing cases).

That the same power to notice a "plain error", though not assigned or specified, is equally applicable to jury actions in civil cases is shown, for example, in *Royal Insurance Company* v. *Miller,* 199 U. S. 353, 369—an action to enforce a policy of fire insurance—where this Court said:

> "As we are at liberty, however, despite the absence of an assignment of error on the subject, to consider a plain error arising on the record, we have given our attention to the subjects referred to * * *".

The court below was equally free to notice and correct "plain error" arising on the record, where that error was a failure of the trial court to instruct the jury upon the statutory requirement for "clarity of phraseology" in patent claims (Rev. Stat. 4888). Although the rules of the Seventh Circuit Court of Appeals contain no specific rule corresponding to paragraph 6 of Rule 27 of this Court, the rules of the court below do contain a Rule 7 reading as follows:

> "The rules of the Supreme Court of the United States and the Federal Rules of Civil Procedure, whenever applicable, shall be followed."

There was no disregard by the court below of the Seventh Amendment to the Constitution nor of Rule 51 of the Rules of Civil Procedure; nor was there any disregard of or conflict with the decisions of this court cited by petitioners. On the contrary the court below followed the established practice, upon noting a "plain error" on the face of the record, of giving its attention to and deciding the issue of "clarity of phraseology".

The Court Below Correctly Ruled That No Instruction Was Given on the Issue of "Clarity of Phraseology" Under Rev. Stat. 4888.

Point 2 of petitioners' "Reasons Relied on for the Allowance of the Writs" (p. 7) and of their "Argument" (pp. 14-16) dispute the conclusion of the court below that "there was no instruction on the matter" of clarity of phraseology of the claims in suit. In support of their contention, petitioners quote on pages 15 and 16 of their brief the parts of the trial court's charge to the jury which they say constituted an adequate instruction in respect of the legal requirements of Rev. Stat. 4888 including the requirement for "clarity of phraseology".

Only a casual comparison of these quoted parts of the trial court's instructions with Rev. Stat. 4888 will suffice to show the correctness of the conclusion of the court below that there was no instruction whatsoever on the matter of "clarity of phraseology". There was not a word said in the instructions that the statute "requires the patentee to state his invention in '*such full, clear, concise and exact terms* as to enable any person skilled in the art or science to which it appertains • • • to make, construct, compound and use the same; and in the case of a machine, *he shall explain the principle* thereof, and the best mode in which he has contemplated applying that

principle, so as to distinguish it from other inventions' " (Opinion below; R. Vol. IV, p. 2779).

It is true that the trial court substantially quoted the requirement that an inventor "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery" but this was done without a word of explanation and with no application whatsoever to the claims in suit.

Furthermore, the instructions were wholly silent upon the invalidating effect of a failure of a patent to comply with all of the requirements set forth in this section of the patent statutes.

That the reading of a statute to a jury by the trial court does not *per se* amount to an instruction is the rule laid down in *Blanos* v. *Kulesva* 107 Conn. 476. In this case the Supreme Court of Errors of Connecticut held an instruction to be defective which merely quoted the pertinent section of a statute and defined a word used therein, but failed to apply the statute to the evidence in the case. The court said, at page 481:

> "It follows that the charge did not properly interpret the statute and failed to furnish the jury with adequate guidance in applying the statute to the evidence in the case."

And in the case of *United Brotherhood of Carpenters and Joiners of America* v. *United States*, 91 L. Ed. (Adv. Ops.) 705, previously mentioned, the dissenting opinion of Justice Frankfurter contains the following observation with which apparently the majority of this Court agreed because the dissent was based upon the interpretation of § 6 of the Norris-LaGuardia Act and not upon the question of the propriety of this Court considering the instructions the trial court had given to the jury:

> "• • • A trial court does not discharge its duty merely by quoting a statute relevant to the conduct of

the trial. The issue before an appellate court is not whether the trial judge might have given a request of abstract correctness, or even charged differently, but whether the judge's instructions were accurate and ample * * *" (p. 717).

Conclusion.

Petitioners have failed to sustain any of the "Reasons Relied on for the Allowance of the Writs". They have failed to show that the court below violated the Seventh Amendment to the Constitution or circumvented Rule 51 of the Rules of Civil Procedure or that its opinion conflicts with any decision of this Court. They have failed to show that the court below misinterpreted the doctrine of the *Halliburton* v. *Walker* decision of this Court or incorrectly applied that doctrine. They have failed to show that the conclusion reached by the court below in the instant case is inconsistent with conclusions reached by it or by this Court in other cases.

On the contrary Respondent has shown that the court below properly exercised its supervisory authority in noticing and considering a "plain error" in the record, and reached a correct conclusion.

The petition should be denied.

Respectfully submitted,

JOHN D. BLACK,
ALBIN C. AHLBERG,
Counsel for Respondent.

ROSS O. HINKLE,
LEON F. SHACKELL,
Of Counsel.